

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT:	NANCE, S.	DOCKET NO.:	4248P2441
SERIAL NO.:	10/086,263	EXAMINER:	COBY, F.
FILED:	03/04/2002	ART UNIT:	2161
TITLE:	METHOD AND SYSTEM FOR LOCATING CELLULAR PHONE NUMBERS		

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March 28, 2007

I hereby certify that on the 28th day of March, 2007, this correspondence is being filed electronically on EFS-Web.

/Veronica-Adele R. Cao/
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APPEAL BRIEF

Dear Examiner Coby:

This Appeal Brief is re-submitted in response to the Notification of Non-Compliant Appeal Brief dated February 14, 2007. The fee for a one-month extension of time accompanies this submission.

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REAL PARTY IN INTEREST

The real party in interest of the present invention is the Applicant, Scott Nance.

REALTED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences pending.

STATUS OF CLAIMS

Claims 1-20 were filed on March 4, 2002 and Claims 21-23 were added in a Preliminary Amendment dated March 18, 2003. In an Office Action dated August 6, 2004, the Examiner rejected Claims 1-23. In response, Claims 1, 21, and 22 were amended in an Amendment Letter dated November 4, 2004. Claims 1-23 were rejected again in an Office Action dated January 19, 2005. A Response to the January 19, 2005 Office Action was filed on April 19, 2005, but the Claims were not amended. Claims 1-23 were finally rejected by the Examiner as noted in an Office Action dated May 27, 2005. A request for reconsideration and a Response were filed August 26, 2005. In an Advisory Action dated September 26, 2005, the Examiner stated that the Applicant's arguments contained in the Response dated August 26, 2005 were unpersuasive. A second Advisory Action was mailed on December

27, 2005 reiterating the Examiner's remarks in the September 26, 2005 Advisory Action. Therefore, Claims 1-23 are being appealed.

STATUS OF AMENDMENTS

A request for reconsideration was filed on August 26, 2005 along with the Response to the Office Action dated May 27, 2005. In an Advisory Action dated September 26, 2005, the Examiner notes that Applicant's arguments allege a patentable distinction between publication of cellular phone numbers and other phone numbers but that there is no such distinction in the context of the claims. A second Advisory Action was mailed December 27, 2005 reiterating the Examiner's position stated in the September 26, 2005 Advisory Action.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The independent claims involved in this appeal are Claims 1, 16, 21, and 22. Independent appealed claims 1 and 16 recite in part:

"compiling a list of cellular phone users from at least one cellular phone provider;
compiling a list of corresponding cellular phone numbers of said cellular phone users;
creating a database of said list of said cellular phone users and said list of corresponding cellular phone numbers of said cellular phone users; and
a user searching said database."

See Specification at p. 6, lines 5-13; and Figure 2. Independent appealed claims 21 and 22 recite in part:

"compiling a list of cellular [Claim 22: wireless type phone numbers]; and
providing in a phone book available to phone users [Claim 22: wireless communication device users] at least a portion of the phone book with a list of compiled cellular phone numbers [Claim 22: compiled wireless communication devices]."

See Specification at p. 6, lines 5-8; and p. 7, lines 14-15.

Dependent appealed claims 2-8, and 13-15 are directed to an alphabetical directory of the cellular phone users and corresponding cellular phone numbers that is published in an electronic network, in a phone book, on a CD-ROM, or in separate directories for separate cellular phone providers and is downloadable to a cellular phone. See Specification at p. 7, lines 14-16; and p. 7, line 23-p. 8, line 3.

Dependent appealed claim 9 is directed to the tagging of cellular phone numbers as unpublished and removing unpublished cellular phone numbers from the list. See Specification at p. 8, lines 3-8.

Dependent appealed claims 10-12 are directed to the database being available to be searched through a dial-in cellular phone directory that is operated by a voice-recognition computer or by a person, where a user can call a directory number and request a

cellular phone number corresponding to a name of a cellular phone user. See Specification at p. 7, lines 14-18 and lines 21-23.

Dependent appealed claims 17-20 are directed to the system generating an audible or textual response to a user's request that provides the requested cellular phone number or indicates that the requested cellular phone number is non-existent or unpublished. See Specification at p. 6, lines 10-21; and Figure 2.

Dependent appealed claim 23 is directed to the wireless telephones being cellular telephones. See Specification at p. 6, lines 1-2

ISSUE

Is the Examiner's rejection of pending Claims 1-23 as being unpatentable over U.S. Patent No. 6,173,045 issued to Smith and U.S. Patent No. 5,901,214 issued to Schaffer properly made and well founded?

GROUPING OF CLAIMS

For purposes of this Appeal, Claims 1-23 stand or fall together as a group.

ARGUMENT

The claims as amended are patentable over U.S. Patent No. 6,173,045 issued to Smith and over U.S. Patent No. 5,901,214 issued to Shaffer; therefore, the Examiner's rejection under 35 U.S.C. §103(a) of pending Claims 1-23 is not properly made and should be reversed.

The prosecution history for this case may be generalized as follows. In an Office Action dated January 19, 2005, the Examiner rejected Claims 1-23 under 35 U.S.C. §103(a) as being unpatentable over Smith and Shaffer. In a Response dated April 19, 2005, Applicant set forth arguments sufficient to distinguish the application from the cited references. Specifically, differs from Smith and Shaffer in that Applicant's claimed invention includes compiling and making available to users a searchable database of cellular phone user names and cellular numbers from data providing by at least one cellular phone provider (Claims 1-23) or of wireless type phone numbers, which may include cellular numbers (22-23).

Smith fails to render obvious Applicant's claimed invention.

Smith is directed to an independent device attached to each user's telephone line that facilitates queries to a telephone company central office. Smith, however, makes no reference

whatsoever to using the device to search or locate wireless or cellular numbers. Smith fails to provide any information that would render obvious Applicant's method for a cellular or wireless type provider to either compile or make publicly accessible a searchable database or users. Instead, the operation of the device of Smith presupposes the existence of a database by a telephone provider. Although cellular or wireless type phone numbers were well known at the time of Smith, Smith does not teach, disclose, or suggest that the device may be used to locate such numbers.

Schaffer also fails to render obvious Applicant's claimed invention. Schaffer is directed to the correlation of data from various independent databases for use by an automated system to intelligently retrieve a wide variety of information relating to incoming phone calls. Although the system of Schaffer is sufficiently flexible to incorporate cellular phone numbers, Schaffer, like Smith, presupposes the existence of a publicly accessible, searchable database of cellular numbers and users in order to incorporate such data. Schaffer in no way teaches how such a database may be compiled from cellular service provider data and made publicly available, and therefore cannot render

Applicant's claimed invention obvious. Even today, no such publicly accessible searchable database exists.

To the extent that Schaffer teaches that reports of changes to telephone numbers may be made available by Bellcore, Schaffer does not indicate that Bellcore provides any information relating to changes in cellular or wireless type numbers. Even if Shaffer is interpreted as suggesting that because such a service exists for non-cellular numbers, such a service could also exist for cellular or wireless type numbers (which interpretation Applicant contests), such an interpretation would again presuppose the existence of an accessible database of such numbers from which changes may be detected and reported, and in no way enables the creation or publication of such a database.

In order for the Claims to be properly rejected as being obvious in light of the combination of Smith and Schaffer, the prior art references must suggest the desirability of the combination. The mere fact that the references may be combined or modified does not in itself render the resultant combination obvious. *See In re Mills*, 916 F.2d 690 (Fed. Cir. 1990). Furthermore, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *See Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Because

no such desirability of combination is suggested, it is improper to reject Claims 1-23 as being obvious in light of the combination of the Smith and Schaffer references.

Even in combination, the Schaffer and Smith references fail to render obvious Applicant's claimed invention. Schaffer teaches a system of linking information from independent databases. Smith teaches an electronic device to send and receive information to a single telephone central office. Both Schaffer and Smith are therefore non-analogous art that may not be properly combined as the Examiner proposes.

Even if combined, however, Smith and Schaffer fail to render obvious Applicant's claimed invention. Both Schaffer and Smith teach inventions whose utility presupposes the existence of an accessible database relating to telephone numbers. Although the Examiner asserts that it would be obvious to generate a directory of cellular numbers, each cited reference fails to demonstrate the existence of such a directory or to teach how such a directory may be compiled or published. Combining the references cannot overcome this failure.

Applicant notes that in light of the fact that traditional telephone directories and cellular and wireless type services are mature, well established and widely used technologies, the non-

obviousness of Applicant's claimed invention is further supported by its novelty.

Finally, Schaffer's teaching that numbers from differing types of phone services may be distinguished by a telephone code is relied upon by the Examiner to support the assertion that directory assistance would not be fundamentally different for cellular numbers than for traditional telephone numbers. Applicant acknowledges that both cellular and non-cellular numbers each comprise ten digits, and therefore Applicant's claimed invention may potentially be practiced using elements taken from non-cellular directory assistance technology. However, the mere fact that an existing technology may be modified for a new use does not render the new use obvious. The similarity between the number of digits in cellular and non-cellular phone numbers is no more than coincidental. Applicant's claimed invention stands on its own and in no way relies upon any similarity between cellular and non-cellular services or numbers, or even between similarities between cellular providers themselves.

Applicant also notes that the existence of substantial distinctions between traditional and cellular or wireless type services, such as different underlying technologies and

infrastructures, business models, markets and market forces, subscriber characteristics and expectations, governmental regulation, and the culture and tradition of the two service types, to name only a few. The presence of these distinctions would be recognized by one of ordinary skill in the art in further support of the non-obviousness of Applicant's claimed invention.

Applicant respectfully submits that the claimed invention provides a useful and non-obvious contribution to the art that deserves patent protection.

Therefore, the Examiner's rejections under 35 U.S.C. §103(a) in light of the Smith and Schaffer patents should be reversed.

CONCLUSION

For the reasons stated above, the Claims as amended by Applicant are in condition for allowance and the Examiner's rejection of Claims 1-23 was improperly made and not well founded. Hence, Applicant respectfully urges the Board to reverse the Examiner's findings.

A payment in the amount of \$60 for a one-month extension of time is submitted herewith. In the event an additional fee or

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extension of time is required, please charge that fee or
extension of time requested to our Deposit Account 23-0830.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method for locating cellular phone numbers comprising, in combination, the steps of:

compiling a list of cellular phone users from at least one cellular phone provider;

compiling a list of corresponding cellular phone numbers of said cellular phone users;

creating a database of said list of said cellular phone users and said list of corresponding cellular phone numbers of said cellular phone users; and

a user searching said database.

2. The method of Claim 1 wherein said database is an alphabetical directory of said cellular phone users and said corresponding cellular phone numbers.

3. The method of Claim 2 wherein said alphabetical directory is published in an electronic network.

4. The method of Claim 2 wherein said alphabetical directory is published in a phone book.

5. The method of Claim 2 wherein said alphabetical directory is published in a CD-ROM.

6. The method of Claim 2 further comprising the step of generating revenue by soliciting advertising in said alphabetical directory.

7. The method of Claim 2 further comprising the step of publishing a separate alphabetical directory for separate cellular phone providers.

8. The method of Claim 2 further comprising the steps of:

compiling a list of cellular phone users of a first cellular phone provider;

compiling a list of cellular phone users of at least a second cellular phone provider;

compiling a list of cellular phone numbers of said cellular phone users of said first cellular phone provider;

compiling a list of cellular phone numbers of said cellular phone users of said at least a second cellular phone provider;

merging said list of cellular phone users and corresponding cellular phone numbers of said first cellular phone provider with said list of cellular phone users and corresponding cellular phone numbers of said at least a second cellular phone provider;

and

creating an alphabetical directory of all cellular phone users and corresponding cellular phone from said first cellular phone provider and said at least a second cellular phone provider.

9. The method of Claim 1 further comprising the steps of:
tagging cellular phone numbers as unpublished at the request
of corresponding cellular phone users; and
removing unpublished cellular phone numbers from said list
of corresponding cellular phone numbers of said cellular phone
users.

10. The method of Claim 1 wherein said database is available
to be searched through a dial-in cellular phone directory capable
of allowing said user to call a designated directory number and
request a cellular phone number corresponding to a name of a
cellular phone user.

11. The method of Claim 10 wherein said dial-in cellular
phone directory is operated by a voice-recognition computer.

12. The method of Claim 10 wherein said dial-in cellular
phone directory is operated by a person.

13. The method of Claim 2 wherein said alphabetical
directory is capable of being downloaded to a cellular phone.

14. The method of Claim 2 wherein said alphabetical directory is capable of being downloaded to a computer.

15. The method of Claim 2 wherein said alphabetical directory is capable of being downloaded to a personal digital assistant.

16. A system for locating cellular phone numbers, comprising, in combination:

- a memory for storing program instructions and data;
- a processor coupled to said memory for executing said program instructions; and
- a user input device coupled to said processor for receiving user input, wherein said program instructions include instructions for
 - compiling a list of cellular phone users from at least one cellular phone provider;
 - compiling a list of corresponding cellular phone numbers of said cellular phone users;
 - creating a database of said list of said cellular phone users and said list of corresponding cellular phone numbers of said cellular phone users;
 - receiving a user input requesting a cellular phone number of a specific cellular phone user;
 - searching said database for a name of said specific cellular phone user;
 - locating said name of said specific cellular phone user from said list of cellular phone users from at least one cellular phone provider;

matching said name of said specific cellular phone user from said list of cellular phone users from at least one cellular phone provider with said corresponding cellular phone number of said cellular phone user; and

generating a response to communicate to a user a corresponding cellular phone number of said name of said specific cellular phone user from said database of said list of cellular phone users and said list of corresponding cellular phone numbers of said cellular phone users.

17. The system of Claim 16 wherein said response is communicated to a user audibly.

18. The system of Claim 16 wherein said response is communicated to a user textually.

19. The system of Claim 16 wherein said response to communicate to a user comprises a message that no corresponding phone number exists for said specific cellular phone user.

20. The system of Claim 16 wherein said response to communicate to a user comprises a message that said corresponding phone number for said specific cellular phone user is unpublished.

21. A method for providing access to cellular phone numbers comprising, in combination, the steps of:

compiling a list of cellular phone numbers; and

providing in a phone book available to phone users at least a portion of the phone book with the list of compiled cellular phone numbers.

22. A method for providing access to wireless type phone numbers comprising, in combination, the steps of:

compiling a list of wireless type phone numbers of at least one type of wireless communication device comprising wireless telephones, personal digital assistants and pagers; and

providing in a phone book available to wireless communication device users at least a portion of the phone book with the list of wireless type phone numbers of the compiled wireless communication devices.

23. The method of Claim 22 wherein said wireless telephones are cellular telephones.